

**REMARKS**

Applicant acknowledges that the Examiner has withdrawn the rejections of record in the January 27, 2003 Office Action.

**Status of the Application**

Claims 1-33 are all the claims pending in the Application. Claims 1-5, 8-16, 19-27 and 30-33 have been rejected.

**Allowable Subject Matter**

Applicant acknowledges that the Examiner has indicated that claims 6, 7, 17, 18, 28 and 29 would be allowed if rewritten in independent form. However, Applicant declines at this time to draft these claims in independent form since the independent claims should be allowed.

**Written Description Rejection**

The Examiner has rejected claims 1, 6, 12, 17, 23 and 28 under 35 U.S.C. § 112, first paragraph, as allegedly not complying with the written description requirement because those claims allegedly contain subject matter that was not described in the Application as filed.

The Examiner takes the position (see numbered paragraph 4 of the Office Action) that “the step of modifying the query to replace one or more selected clauses with a false clause was not described in the specification (as disclosed in the specification, pages 11 and 12-13, two false clauses were generated for a SQL statements [sic] has two WHERE clauses).”

Applicant respectfully submits that the Examiner’s position is both incorrect and insufficient to support a rejection under 35 U.S.C. § 112.

As an initial matter, Applicant submits that the Examiner has failed to meet his burden of “presenting evidence or reasons why persons skilled in the art would not recognize in the

disclosure a description of the invention defined by the claims.” This evidence is necessary to overcome the strong presumption that an adequate written description of the claimed invention is present when the Application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976), MPEP § 2163(I)(A). In fact, as the rejected claims have not been amended and were part of the Application as originally filed, a strong presumption attaches that the written description requirement is satisfied.

Here, the Examiner merely presents a conclusory argument, with no supporting reasoning why one of skill in the art would not recognize the clear exemplary description of the claimed matter in the Specification. Thus, the written description rejection is unsupported, and the strong presumption of an adequate written description is not rebutted.

Further, the Examiner’s position is factually incorrect, as the subject matter of claims 1, 6, 12, 17, 23 and 28 is fully described in *at least* page 10, line 26 through page 11, line 15 of the Specification, which indicates:

The Metadata extraction system 220 alters the SELECT statement by adding/inserting a false WHERE condition (e.g., WHERE 1 = -1). The inclusion of the false WHERE condition results in no rows being returned while metadata about the result set is available. In particular, even though no rows are returned, the MetaData via a Java.sql.ResultSetMetaData field is still available and used to construct the iterator necessary for the generating SQLJ code where a SELECT statement is returning rows of data.

Since SQL is a complex language where there are a minimal set of reserved words, one or more false SQL statements are constructed and loaded into a list of statements to run. In one embodiment, the number of false SQL statements will be equivalent to the number of WHERE clauses. For example, if a SQL statement has a WHERE clause, then one false WHERE clause is generated and used to replace the original WHERE clause and anything following it (e.g., a GROUP BY clause). If a SQL statement has two WHERE clauses, then one false WHERE clause is generated and used to replace both of the WHERE clauses and everything following them and a second false WHERE clause is

generated and used to replace the second WHERE clause and everything following it (i.e., this leaves the first WHERE clause in the SQL statement. The first SQL statement with a false WHERE clause to run without experiencing a SQL exception is the one used to extract the MetaData.

In view of at least the written description noted above, it is clear that a person of ordinary skill in the art would have understood that the inventors had possession of the claimed subject matter since the Application as filed fully supports the limitations recited in claim 1, 12 and 23 concerning modifying the query to replace one or more selected clauses with a false clause.

Thus, Applicant respectfully submits that, in addition to the unsupported nature of the instant written description rejection, it is clear that claims 1, 6, 12, 17, 23 and 28 are fully supported by the original disclosure of the Application. Thus, Applicant respectfully requests withdrawal of this rejection.

**Utility Rejection**

The Examiner has rejected claims 1, 12 and 23 under 35 U.S.C. § 101 as being inoperative and therefore lacking utility. This rejection is respectfully traversed.

As an initial matter, Applicant notes that, to support a rejection of a claim under 35 U.S.C. § 101 for reciting inoperative subject matter, “the claimed device must be totally incapable of achieving a useful result.” *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992). Clearly, it is not “essential that the invention ... operate under all conditions.” *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8<sup>th</sup> Cir. 1980).

Here, the Examiner has not indicated any belief that the claimed invention is “totally incapable of achieving a useful result.” In fact, the Examiner only alleges that the invention does

not work in a single proffered hypothetical. Accordingly, the 35 U.S.C. § 101 rejection is unsupported.

Further, Applicant respectfully submits that the Examiner is simply incorrect with respect to the allegation that the claimed invention would not function in the proffered hypothetical SQL query.

Specifically, the Examiner alleges, in numbered paragraph 6 of the Office Action, that:

... if a query having a selected clause replaced by false clause, for example, with a simple SQL query: SELECT, FROM, WHERE wherein WHERE is selected to be replaced and executed. A user either receives a result set having no data, or an error message from the SQL compiler. Metadata is data about data. For example, the title, subject, author, and size of a file constitute metadata about the file. Thus, if there is no data being returned, there will be no metadata of the data being retrieved, and the step of retrieving metadata from the result set is inoperative.

In other words, the Examiner seems to believe that if a result set having no data is returned (i.e., when a false WHERE clause is inserted into a SQL statement), then no metadata would be retrieved, because "Metadata is data about data." The Examiner cites no supporting material to buttress this bare allegation.

In any event, the Examiner is incorrect. As is abundantly clear from the Specification, when a SQL statement is modified to replace, for example, a WHERE clause(s) with a logically false statement (i.e., WHERE 1 = -1), no data is returned when the clause is executed because no row in the result set can satisfy the logically false condition. However, metadata for any data that would be returned if the false condition were not present is returned. See pg. 11, lines 1-4.

Thus, it is clear that the claimed invention is operative at least because of the metadata that is returned, and therefore meets the utility standard. Accordingly, Applicant respectfully requests withdrawal of this rejection.

**Obviousness Rejection**

The Examiner has rejected claims 1-5, 8-16, 19-27 and 30-33 under 35 U.S.C. § 103(a) as being unpatentable over what the Examiner has alleged to be Applicant's "*Admitted Prior Art*" (hereinafter "*AAPA*") set forth in the "related art" section of the Application (pgs. 1-2). This rejection is respectfully traversed.

As an initial matter, Applicant notes that the subject matter discussed in pages 1-2 of the instant Application is described as "related art." There is no admission that any of the subject matter therein is "Prior Art." However, even if the subject matter from pages 1 and 2 is deemed to be prior art, it does not render the claims obvious.

*AAPA* discloses that: (1) the DB2 database system contains a DESCRIBE command that lists column names and data types of a query result; (2) an SQLJ iterator describes columns for a result set using Java types; and (3) that the DB2 Ver. 5 does not provide a DESCRIBE command, but that a DML statement may be formulated to allow full access to metadata similar to the DESCRIBE command. *AAPA* further indicates that there is a need in the art of an improved technique of obtaining metadata when these direct access methods are not available.

**Independent Claims 1, 12 and 23**

The Examiner takes the position that *AAPA* discloses that "if a system does not have the DESCRIBE command, a developer can alter the DML statement to return no data but allow full access to the metadata." Thus, the Examiner alleges that the *AAPA* discloses the claimed features of "modifying the query" for "retrieving metadata."

However, the Examiner concedes that *AAPA* "does not explicitly teach the steps of 'modifying the query to replace one or more selected clauses with a false clause;' [and]

‘executing the modified query with the false clause’” (numbered paragraph 8 of the Office Action).

Applicants agree that the AAPA fails to teach or suggest any use of a false clause in a query.

Nevertheless, the Examiner alleges that one of ordinary skill “would know SQLJ allows SQL statements to be embedded in a Java program, and a false clause when added to a set of SQL statements will return no data.” Thus, the Examiner alleges that it “would have been obvious ... to modify [AAPA] by using a false clause to replace one or more selected clauses in order to return no data from an embedded SQL query in a SQLJ program.”

In contrast, Applicants respectfully submit that one of skill would not have been motivated to modify AAPA as the Examiner has alleged. Specifically, it has long been held that the Examiner must “show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for a combination in the manner claimed.” *In re Rouffet*, 47 USPQ2d 1453 (Fed.Cir. 1998). The mere fact that references can be “combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination [or modification].” *In re Mills*, 916 F.2d 680 (Fed.Cir. 1990); MPEP §2143.01.

Here, each of the disclosed AAPA methods of returning metadata, including the formulated DML statement cited by the Examiner, actually return metadata without the use of a “false clause.” Thus, there would have been no motivation to modify these systems to provide a function that they already perform.

Additionally, even if there were some identifiable motivation to modify *AAPA* as the Examiner has alleged, Applicants respectfully submit that the *AAPA* fails to teach or suggest any use of a “false clause,” or that a “false clause” could be used with a DESCRIBE command, a SQLJ iterator, or a DML statement. In fact, the Examiner has specifically conceded that there is no teaching or suggestion of any use of such “false clause” in the *AAPA*.

Thus, it is clear that the Examiner has not established *prima facie* obviousness, as he has not identified the use of any “false clause” in any “prior art.” Specifically, it has long been held that “to establish *prima facie* obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art” (emphasis added). *In re Royka*, 490 F.2d 981 (CCPA 1974).

In fact, the only discussion of even the general use of a “false clause,” and of its specific application to “modify a query,” is found in Applicant’s description of his invention. Thus, it seems that the Examiner is basing his entire obviousness argument on Applicant’s description of the invention. Of course, this is improper, as the Examiner is utilizing knowledge gleaned from Applicant’s disclosure, which is impermissible hindsight. *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

Thus, Applicant respectfully submits that independent claims 1, 12 and 23 are patentable over *AAPA*. Further, Applicant respectfully submits that rejected dependent claims 2-5, 8-11, 13-16, 19-22, 24-27 and 30-33 are allowable, *at least* by virtue of their dependency.

Thus, Applicants respectfully request that the Examiner withdraw this rejection.

**Conclusion**

In view of the foregoing, it is respectfully submitted that claims 1-33 are allowable.  
Thus, it is respectfully submitted that the application now is in condition for allowance with all of the claims 1-33.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Please charge any fees which may be required to maintain the pendency of this application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,



Timothy P. Cremen  
Registration No. 50,855

SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, D.C. 20037-3213  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: January 22, 2004